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1 RECORD OF ORAL HEARING
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3 UNITED STATES PATENT AND TRADEMARK OFFICE
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6 BEFORE THE BOARD OF PATENT APPEALS
7 AND INTERFERENCES
8
9

10 *Ex parte* JEAN-LOUIS GUERET
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13 Appeal 2009-005909
14 Application 10/779,725
15 Technology Center 3700
16
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18 Oral Hearing Held: May 12, 2010
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21 Before JENNIFER D. BAHR, STEFAN STAICOVICI, and
22 FRED A. SILVERBERG, *Administrative Patent Judges*.
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1 The above-entitled matter came on for hearing on Wednesday, May
2 12, 2010, commencing at 1:04 p.m., at the U.S. Patent and Trademark
3 Office, 600 Dulany Street, Alexandria, Virginia, before Victoria L. Wilson,
4 Notary Public.

5 THE USHER: Calendar number 51. Appeal number 2009-5909.
6 Mr. Whitehead.

7 JUDGE BAHR: Good afternoon, Mr. Whitehead. You can get started
8 whenever you are ready.

9 MR. WHITEHEAD: Good afternoon. I'm Andy Whitehead and I represent
10 the Appellant in this appeal.

11 For brevity, in view of the 20 minutes we are given, I will be addressing
12 claim one and its dependent claims; however, the other independent claims,
13 34 and 42, are also addressed in the Appeal Brief.

14 As I will discuss, the Examiner's anticipation and obviousness rejections
15 should be withdrawn for at least those reasons discussed in the Appeal Brief
16 and further discussed here today.

17 I'll begin with a brief description of the applicator of claim one. And, among
18 other features, the applicator of claim one comprises a base portion that
19 carries an applicator element. The base portion of the applicator is
20 configured for fixing onto a receptacle. Further, a handle portion is rotatably
21 mounted onto the base portion. The handle portion and the base portion
22 cooperate to enable user to secure the handle in at least two application
23 positions.

24 Features of claim one allow a cosmetic to be applied with varied techniques
25 or to provide improved ergonomics when using right- and left-hand

1 movement, yet, still allow the applicator base to be secured to a receptacle
2 for closure when not in use.

3 The Examiner's anticipation rejection should be withdrawn because Stange
4 does not describe these features of claim one. First, Stange does not
5 describe any receptacle. Stange describes a standalone brush that's clearly
6 designed to be placed onto a table when not in use. Stange is simply
7 configured to rest upon a table and is actually configured not to need any
8 receptacle at all. In fact, Stange states that no device for hanging up the
9 brush is required. So, the reason Stange does not describe the receptacle is
10 because it enables user to rotate the brush into a drying position when placed
11 upright on the table; thus, there is no need for any receptacle or any
12 configuration to be fixed onto a receptacle.

13 Further, one would not desire to fix Stange onto a receptacle because you
14 assume that, in doing so, if you attach a receptacle to the brush, it would
15 prevent the drying action from occurring. So, the Examiner's mere
16 allegation that Stange could be fixed to some undisclosed receptacle does
17 not anticipate these features of claim one.

18 As we know, a mere capability of being modified does not establish
19 anticipation. So, for similar reasons, the Stange reference does not
20 anticipate the applicator of claims 34 and 42 or the method of claim 37.

21 JUDGE SILVERBERG: Excuse me, counsel. The Examiner put forth the
22 position that there is a third position. You identified two applications and
23 drying and the Examiner stated it could be put on a receptacle for storage
24 and any friction fit type of arrangement.

25 MR. WHITEHEAD: The Examiner did allege that. The Stange reference
26 doesn't disclose any type of receptacle at all, so, really, the Examiner is -- is

1 using speculation to assume that some receptacle may be able to be fit to the
2 device in some manner.

3 JUDGE SILVERBERG: What is configured -- can you assist us here and
4 provide us with what does "configured to fit" and whether that's defined in
5 the spec, so that we can refer to it?

6 MR. WHITEHEAD: Yes. The "configure to fit," essentially, is described in
7 the specification at paragraphs 72 to 74 where there essentially could be a
8 threading or a groove to cooperate with a corresponding bead of a neck on a
9 receptacle, something along those lines where the "configure to fit onto a
10 receptacle" would impart some sort of structural limitation to the design of
11 the base.

12 JUDGE BAHR: What about a friction fit, configured for a friction fit?

13 MR. WHITEHEAD: Right. Friction fit is also available as a means to fit a
14 receptacle on there, and that -- the device would be specifically configured
15 to have a receptacle fit closely enough where a friction fit would operate.

16 JUDGE BAHR: Well, the receptacle is not part of the claim, though; right?

17 MR. WHITEHEAD: Correct, we are not claiming a receptacle.

18 JUDGE BAHR: So it would be configured to fit onto a receptacle having an
19 inner diameter that would be appropriate for a friction fit with the base of
20 Stange.

21 MR. WHITEHEAD: Correct. In a friction fit instance, that would be a
22 correct interpretation.

23 JUDGE BAHR: You can go ahead.

24 MR. WHITEHEAD: Okay. Regarding the obviousness rejection relying
25 upon the Vasas reference, in view of Stange, this should also be withdrawn
26 because the combination of these references would not have rendered

1 obvious claim one.

2 The Vasas reference describes an ordinary style mascara brush, including a
3 handle that is fixed in a single position. It is essentially disclosed in a
4 straight line with the brush. One of ordinary skill in the art would not have
5 combined the mascara brush of Vasas with the shaving brush of Stange. The
6 Examiner alleges that one would have combined Vasas with Stange to make
7 a more ergonomic handle but, again, this allegation is incorrect.

8 Neither Stange nor Vasas describe any ergonomic benefits associated with a
9 handle having the multiple positions. Instead, Stange describes only that the
10 handle can move to allow drying of the bristles. Thus, the ergonomics
11 rationale appears to be impermissible hindsight by the Examiner.

12 Additionally, one looking from Vasas to Stange would not have had a reason
13 or rationale to combine a drying position of Stange with the mascara brush
14 of Vasas. One would not desire to dry a mascara brush because, after use,
15 the mascara itself would, you know, form a crust which would be an
16 undesirable after effect on a mascara brush.

17 So, looking at this, having no ergonomic benefit or other feature associated
18 with it in the Stange reference, one would not have had any reason or
19 rationale to combine these references.

20 JUDGE SILVERBERG: Counsel, might you take a look at Vasas and assist
21 us a little bit. Column 5, lines 35 -- basically, 35 through 52, but, in
22 particular, let's look at line 40 -- 40 -- lines 42 through 46 where Vasas
23 discloses using the brush with applicator bristles, 50, and then -- in one part,
24 and then going to a second position by rotating the brush 180 degrees to use
25 the profile cone.

1 One -- one having ordinary skill in the art, instead of rotating the whole
2 brush, would they not look to Stange for a brush that could pivot so you can
3 still hold it in one hand and then turn it and then use the other side of the
4 brush, as opposed to taking the whole brush and rotating it 180 degrees.

5 MR. WHITEHEAD: It is my understanding that this disclosure in Vasas is
6 different, in the sense that a rotation of 180 degrees in Vasas rotates the
7 applicator brush, which is actually different on both sides. As you can see in
8 figure one, there is a concave side of the brush and also a convex side of the
9 brush. So, in Vasas, one actually needs to rotate the entire brush
10 180 degrees to use the alternate side, whereas, if you merely rotated the
11 handle, you would still be using the same side of the brush but in a different
12 handle position.

13 JUDGE SILVERBERG: Maybe I'm missing something, but if you rotate the
14 brush, you are using the other side of the brush. The handle is still in your
15 hand, so you don't have to remove it, so you get stability by holding the
16 handle and rotating it so you can use it, as opposed to taking the thing and
17 grabbing it and moving it where it could slip out of your hand and get the
18 mascara on your hands or whatever but --

19 MR. WHITEHEAD: I understand what you are saying.

20 JUDGE SILVERBERG: I just want you to address that so that we can --

21 MR. WHITEHEAD: Right. I think that, obviously, rotating the handle to
22 put the brush in an alternate position is available, however, Stange, in
23 combination, would lead one to believe this is merely for a drying position,
24 and there is no disclosure in any of the references that would lead one to
25 believe this is an improvement to assist the user in using the brush in the
26 disclosed manner of Vasas.

1 And moving onto the next obviousness rejection, which is Stange in view of
2 Shay, for dependent claim seven, as discussed, Stange does not describe
3 being configured for fixing onto a receptacle and the
4 Examiner acknowledges that Stange does not describe a base portion that
5 comprises the closure cap for a receptacle as recited in claim seven.

6 The Examiner relies upon Shay to remedy these deficiencies, but, again, one
7 of ordinary skill in the art would not have had a reason or rationale to
8 combine Stange with Shay because Shay requires that the brush be stored in
9 an upside-down position in the receptacle when not in use, whereas, Stange
10 requires that the brush be placed upright on a table to dry.

11 As discussed in Stange, it is -- it is recited that no device for hanging up the
12 brush is required. So, storing Stange, really, in the receptacle of Shay would
13 appear to go against the intended purpose -- the drying recited in the Stange
14 reference. So being that there is no reason or rationale to combine the two
15 references, this rejection should also be withdrawn.

16 JUDGE SILVERBERG: Stange -- excuse me. Stange talks about drying
17 but where is it -- please assist us. Where does it say storage? It says left
18 there for storage on the counter -- or why, taking it and turning the brush
19 upside-down after it is already dried and then screwing it into the -- in the
20 manner to which Shay describes, would not effectively work for storage?
21 Why is that precluded by Stange?

22 MR. WHITEHEAD: Stange does not explicitly state that it cannot be stored
23 in any such receptacle. It is just simply not addressed. But what is
24 addressed is that no additional device for hanging up the brush is required,
25 which appears to be exactly what the Shay reference is, which would be that
26 additional device for hanging up the brush.

1 JUDGE SILVERBERG: Where in Stange is that disclosed? Here it is. I've
2 got it.

3 MR. WHITEHEAD: Yes. On page two.

4 JUDGE SILVERBERG: Yeah. The end of the -- it is in the middle of the
5 page.

6 MR. WHITEHEAD: Correct.

7 JUDGE SILVERBERG: And that's for hanging up the brush just to dry, not
8 for storage.

9 MR. WHITEHEAD: Correct. Storage of Stange device is not described.
10 So the other rejections by the Examiner relate merely to other dependent
11 claims and rely upon additional references that don't remedy these
12 deficiencies of Vasas and Stange and those are discussed in the Appeal
13 Brief, as such.

14 So for these reasons presented today, we ask the Hhonorable Board to
15 reverse the Examiner's rejection.

16 JUDGE SILVERBERG: Thank you.

17 JUDGE BAHR: Any further questions?

18 JUDGE STAICOVICI: Yes, I have a question with respect to Stange. Why
19 do you believe that the frusto-conical surface on the sides of the brush
20 cannot be used for fixing a receptacle?

21 MR. WHITEHEAD: We simply don't know enough about the Stange device
22 to make that determination. What we do know and what is disclosed in
23 Stange is that no additional receptacle is required and the brush is designed
24 as a standalone unit.

1 Any -- you know, this frusto-conical design, as you called it, being able to be
2 fixed to a receptacle, some receptacle that's undisclosed, would merely be
3 happenstance.

4 JUDGE BAHR: Anything else?

5 I think we understand your position. We'll take this case under advisement.

6 Thank you.

7 MR. WHITEHEAD: Thank you very much.

8 Whereupon, the proceedings at 1:19 p.m. were concluded.

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